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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/214,022 12/23/98 LASSON R TP1192-US

IM62/1102
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EXAMINER

CHEVALIER, A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 11/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/214,022

Applicant(s)

Lasson

Examiner

Alicia Chevalier

Group Art Unit

1772



☒ Responsive to communication(s) filed on Aug 24, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 14-17 and 19-30 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 14-17 and 19-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 rejection of claims 14-18 as indefinite of record in paper #4, page 3, paragraph #9 has been withdrawn due to Applicant's amendment in paper #9.
2. The 35 U.S.C. 102 rejection of claims 14, 16, 21, 24-25, 27, and 30 as anticipated by Zinn (2,558,918) of record in paper #4, page 5, paragraph #16 has been withdrawn due to Applicant's amendment in paper #9.

REJECTIONS REPEATED

3. The 35 U.S.C. 102 rejection of claims 14-16, 19-21, 24-25, 26, and 29-30 as anticipated by Skjelby (4,206,867) is repeated for reasons previously of record in paper #4, page 5, paragraph #15.
4. The 35 U.S.C. 103 rejection of claims 22, 23, 26, and 28 over Skjelby (4,206,867) is repeated for reasons previously of record in paper #4, page 6-7, paragraph #19.
5. The 35 U.S.C. 103 rejection of claim 17 over Skjelby (4,206,867) is repeated for reasons previously of record in paper #8, page 3-4, paragraph #9.

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NEW REJECTIONS

6. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 102

7. Claims 14-16, 19-21, 24-25, 27, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Skjelby (4,206,867).

Claims 14-16, 19-21, 24-25, 26, and 29-30 are rejected by Skjelby for reasons previously of record in paper #4, page 5, paragraph #15.

As for the new limitation of the first and second layers are separable from one another Skjelby also anticipates this limitation. Separable is defined by Merriam-Webster's Collegiate dictionary, tenth edition as capable of being separated or dissociated. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Also, since Skjelby discloses that not all the fold regions are treated with an adhesive (col. 7, lines 31-49) the coated paper board container is capable of having its layer separated. Plus, since Skjelby discloses the same layers desired by applicant it is inherent that first and second layers are separable from one another.

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ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. 112 rejections of record have been considered but are moot since the rejections have been withdrawn.

9. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. 102 rejection with the Skjelby reference have been carefully considered but are moot due to the new grounds of rejections.

10. Applicant's arguments filed in paper #9 regarding the 35 U.S.C. 102 rejection with the Zinn reference of record have been considered but are moot since the rejection has been withdrawn.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Ellis P. Robinson can be reached by dialing (703) 308-2364. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

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October 29, 2000


Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700